

REMARKS

The Office Action dated May 5, 2008 has been received and carefully studied.

The Examiner requires restriction to one of seven Groups, and an election of species. Applicants hereby elect Group I, claims 1-12 and 19-21, and species (i), compounds when $n=1$ and $m=0$, with traverse.

Applicants respectfully but vigorously traverse the Examiner's restriction requirement. The restriction requirement is based on the mere fact that the international search report identifies U.S. Patent No. 5,246,798 as an "X" document. This same document is mentioned in the application at page 4, lines 5 to 7 in the form of its German family member DE 39 22 160. US '798 relates to lead acid accumulators and discloses the prevention of deposits through the use of surfactants, preferably of the amide or amine type, and the examples are in fact exclusively with amides and amines. The present application teaches the use of long chain alcohols, alkoxyated fatty alcohols, polyacrylic acid and polymethacrylic acid to increase the oxidation stability specifically of separators for lead acid accumulators.

As a matter of fact, the claims were amended in the international phase, and the amended claims (on which the presently pending claims 1 to 21 are based) did actually receive a positive International Preliminary

Examination Report (IPER). A copy is enclosed for the convenience of the Examiner. The following are the comments under item 3.1 of the IPER with respect to US'798 and non-anticipation:

"Document D1 [i.e., US'798] discloses separators for lead acid accumulators on the basis of ultra high molecular weight polyethylene (column 3, lines 55 to 59) and a surface active additive which reduces deposits. The additives mentioned are ethoxylated alcohols, ethoxylated fatty acids, amides or amines (column 2, lines 42 to 48; column 5, lines 4 to 8). These surfactants can be introduced into the separator, the electrodes or the electrolyte (column 5, lines 22 to 56). In order to arrive at the claimed separators, a person skilled in the art must make a twofold selection: concerning the nature of the additive, and the place inside the battery at which the additive must be introduced."

The IPER goes on under item 4 with respect to a non-obviousness:

"Document D1 is considered to be the closest prior art. The feature which distinguishes claims 1 to 18 from D1 is the introduction of a special additive into the

separator (selection from two lists). The resulting effect is prolonged service life (application, page 2, line 13). The objective technical problem is that of increasing the oxidation stability of the separator. This problem is solved by the introduction of a special additive. Neither D1 [i.e., US '798] nor D2 [i.e., US 4,778,601] suggests that the oxidation stability of battery separators can be improved by the claimed compounds used. Consequently, claims 1 to 18 are novel and inventive."

Accordingly, all claims which contain a reference to the specific additives of the formula (I) as well as separator do contain the technical features which defines the common inventive concept in accordance with PCT rules 13.1 and 13.2. The claims of groups I to VII as identified by the examiner all contain a specific reference to formula (I) and the battery separator, or an implicit reference through the reference to claim 1. Thus, there is no lack of unity. Indeed, there was no lack of unity objection in the international phase, neither in the search report nor in the IPER.

With respect to the restriction requirement for the product versus the process claims, Article 27(1) PCT stipulates that no national law shall require compliance with requirements relating to the form or contents of the international application

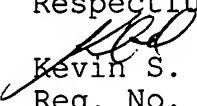
different from or additional to those which are provided for in the PCT. Thus, the USPTO has to follow Rules 13.1 and 13.2 PCT when considering unity of invention of claims of different categories. See also MPEP section 1850 (in particular paragraph I) as well as 37 USC 372 (2). According to Rules 13.1 and 13.2, PCT claims relating to a product and to a process specifically adapted for the manufacture of this product should always be allowable. In this regard, please note that according to section 1850 III.A MPEP the words "specially adapted" are not intended to imply that the product could not also be manufactured by a different process.

With respect to group II, i.e. claim 13 directed to a separator, it is correct that it refers to a component, but it requires that the component can form a compound of Formula (I), so this claim also does not lack unity.

In other words, Formula (I) is the generic formula providing for unity, which is why the objection under item 3 of the office action should also not be pertinent in the present case.

Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the foregoing.

Respectfully submitted,


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